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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,587	04/20/2001	Robert Sage Blackman	20313-011	1413

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EXAMINER

VEILLARD, JACQUES

ART UNIT PAPER NUMBER

2165

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/839,587

Applicant(s)

BLACKMAN ET AL.

Examiner

Jacques Veillard

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the Applicant's communication filed on 4/20/2001.
2. Claims 1-42 are pending and presented for examination, upon which, claims 1 and 36 are the independent claims. Other claims are the dependent.

Priority

3. Applicant's claim for domestic priority under 35 U.S.C. 119(e) of the US provisional applications serial number 60/198,731, filed on 4/20/2000 and serial number 60/209,866, filed on 6/7/2000 is acknowledged. ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claim 1-23 and 36-42 are rejected under 35 U.S.C. 101 because they are directed to non-statutory subject matter, specifically, as directed to an abstract idea.

As per claims 1 and 36, the language of the claims raises a question as to whether the claims are directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U. S.C 101.

As per claims 2-23 and 37-42, they contain also the same deficiency in virtue of dependency of claims 1 and 36.

Claim Rejections - 35 USC § 102

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6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1- 42 are rejected under 35 U.S.C. 102(b) as being anticipated by Shirley et al.(U. S. Pat. No. 5,692,206)

As per claim 1, Shirley et al. disclose “a method and apparatus for automating the generation of a legal document” by providing a contract generation system that automates the generation of various legal documents related to a negotiated agreement (See Shirley et al. Title and Abstract). In particular, Shirley et al. disclose the claimed limitations of “formulating a request by a first party for an agreement with a second party, the request containing an agreement ID that uniquely identifies the request and any agreement formed therefrom”(See Shirley et al. col.12, lines 32-38, Figs.7, 9 and corresponding text, Fig.11B, components 860, 866, 872 and corresponding text). Also Shirley et al. disclose the claimed limitations of “sending the request to the second party” (See Shirley et al. Abstract, col.3, line 56 through col.4, line 24); “receiving correspondence from the second party regarding the request or any agreement formed therefrom” (See Shirley et al.(See Shirley et al. col.10, lines 7-16). Further, disclose the claimed limitations of “saving the correspondence from the second party according to the unique agreement ID” (See Shirley et al. col.10, lines 16-18 and lines 54-62).

As per claim 36, the claim has substantially the same limitations as claim 1. These limitations have already been discussed in the rejection of claim 1. In addition, Shirley et al.

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further disclose the claimed limitations of “linking the second agreement to the first agreement by including the first agreement ID” by providing a site number or information to identify the contract (See Shirley et al. col.10, lines 19-28 and col.12, lines 32-38) and also disclose the claimed limitations of “in the field identifying a downstream agreement to form a supply chain among the first, second and third parties” (See Shirley et al. col.7, lines 22-40, and Fig.7 col.8, lines 18-48). Therefore, it is rejected on similar grounds corresponding to the argument given for the rejected claim 1 above.

As per claims 2 and 24, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant’s attention is directed to the rejection of claim 1 above. In addition, Shirley et al. disclose the claimed limitations of “wherein the first party has an independent agreement database” (See Shirley et al. Fig.2 component 202 correspond to an independent agreement database); further including the step of storing the request in the agreement database in a record that includes or is linked to the agreement ID, after formulating the request (See Shirley et al. col.4, lines 40-58); and wherein the step of saving the correspondence from the second party includes storing the second party correspondence in the agreement database of the first party in a record that includes or is linked to the agreement ID (See Shirley et al. col.10, lines 16-22).

As per claims 3, 12, 25 and 31, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant’s attention is directed to the rejection of claim 1 above. In addition, Shirley et al. disclose the claimed limitations of “wherein the correspondence from the

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second party includes information relating to a counter offer, a request for clarification, an acceptance or a rejection of the request or a notification that the correspondence from the second party will be delayed” (See Shirley et al. 10, lines 1-17).

As per claims 4, 9, 13 and 18, Shirley et al. disclose the invention substantially as claimed. In addition, Shirley et al. disclose the claimed limitations of “wherein the correspondence from the second party is encapsulated in an electronic mail message that contains the agreement ID” (See Shirley et al. Fig.8 component 722 and col.4, lines 59-65).

As per claims 5, 8, 26, 29, Shirley et al. disclose the invention substantially as claimed. In addition, Shirley et al. disclose the claimed limitations of “wherein the correspondence from the second party includes a main body of information and an attachment to the main body; and wherein the attachment is according to the agreement ID” (See Shirley et al.col.5, lines 31-46).

As per claims 6 and 27, Shirley et al. disclose the invention substantially as claimed. In addition, Shirley et al. disclose the claimed limitations of “wherein the correspondence from the second party includes information unrelated to the formation or modification of the agreement, yet still related to the agreement” (See Shirley et al. Fig. 11B components 862, 868, 874 and corresponding text).

As per claims 7, 16, 22, 28, and 34, Shirley et al. disclose the invention substantially as claimed. In addition, Shirley et al. disclose the claimed limitations of “wherein the correspondence from the second party is taken from the group consisting of: a facsimile

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transmission, an electronic mail message, a letter sent by post, or an HTML document”(See Shirley et al. Fig.8 component 722 and col.12, lines 3-18).

As per claims 10, 14, 17, 23, 30, 32, and 35, Shirley et al. disclose the invention substantially as claimed. In addition, Shirley et al. disclose the claimed limitations of “further including the steps of: sending correspondence from the first party to the second party relating to the request or any agreement derived therefrom; and saving the correspondence from the first party relating to the request according to the unique agreement ID given the request” (See Shirley et al. Abstract, Fig.7 component 660 and col.9, lines 27-30).

As per claims 11, 19, and 20, Shirley et al. disclose the invention substantially as claimed. In addition, Shirley et al. disclose the claimed limitations of “wherein the step of saving the correspondence from the first party relating to the request includes storing the first party correspondence in the agreement database of the first party in a record that includes or is linked to the agreement ID” (See Shirley et al. Abstract, Fig.12C component 936. and col.19, lines 4-18).

As per claims 15, 21, and 33, Shirley et al. disclose the invention substantially as claimed. In addition, Shirley et al. disclose the claimed limitations of “wherein the correspondence from the first party includes information unrelated to the formation or modification of the agreement, yet still related to the agreement”(See Shirley et al. Fig.7, and col.4, lines 40-58).

As per claims 37 and 39, most of the limitations of this claim have been noted in the rejection of claim 36. Applicant's attention is directed to the rejection of claim 36 above. In addition, Shirley et al. disclose the claimed limitations of "wherein the step of linking includes: specifying the first deliverable in the second request based on the deliverables of a list of customers (See Shirley et al. col.10, lines 48-62 and col.17, lines 1-17), each having a deliverable due from the second party (See Shirley et al. Abstract, col.3, line 56 through col.4, line 24); and obtaining the first agreement ID based on the deliverable specified (See Shirley et al. col.10, lines 7-16)".

As per claims 38 and 40, most of the limitations of this claim have been noted in the rejection of claim 36. Applicant's attention is directed to the rejection of claim 36 above. In addition, Shirley et al. disclose the claimed limitations of "wherein the step of formulating the second request includes specifying a second deliverable and a date and time for the second deliverable (See Shirley et al. col.2, lines 14-18, col.10, lines 10-12 and lines 52-62); and wherein the step of linking includes: specifying the first deliverable in the second request based on the deliverables of a list of customers (See Shirley et al. col.10, lines 48-62 and col.17, lines 1-17), each having a deliverable due from the second party with a due date and time subsequent to the date and time of the second deliverable (See Shirley et al. col.2, lines 14-18, col.10, lines 10-12 and lines 52-62); and obtaining the first agreement ID based on the deliverable specified (See Shirley et al. See Shirley et al. col.10, lines 7-16)".

As per claims 41 and 42, most of the limitations of this claim have been noted in the rejection of claim 36. Applicant's attention is directed to the rejection of claim 36 above. In addition, Shirley et al. disclose the claimed limitations of "wherein the step of formulating the second request includes specifying a folder and a second deliverable (See Shirley et al. Fig.1B component 200, Fig.5 component 200, Fig.8, Fig.9, col.6, lines 30-41, line 56 through col.7, lines 13, and col.12, line 28 through col.13, line 8); and wherein the step of linking includes: specifying the first deliverable in the second request based on the deliverables of a list of customers included in the specified folder (See Shirley et al. col.10, lines 48-62 and col.17, lines 1-17); and obtaining the first agreement ID based on the deliverable specified (See Shirley et al. col.10, lines 7-16)".

Other Prior Art Made Of Record


8.	Weatherly et al.	U. S. Pat. No. 6,049,784,
	Egendorf	U. S. Pat. No. 6,351,739,
	Hardy et al.	U. S. Pat. No. 6,161,121,
	King et al.	U. S. Pat. No. 5,704,045,
	Thiessen	U. S. Pat. No. 5,495,412,
	Kida	U. S. Pat. No. 5,907,829,
	Dykstra et al.	U. S. Pat. No. 5,611,052, and
	Brandt et al.	U. S. Pat. No. 6,714,979.

Conclusion

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9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacques Veillard whose telephone number is (571) 272-4086. The examiner can normally be reached Monday through Friday from 9:30 AM to 4: 30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici, can be reached on (571) 272-4083. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.


CHARLES RONES
PRIMARY EXAMINER



Jacques Veillard
Patent Examiner TC 2100

November 8, 2004